

REMARKS

The Applicants thank the Examiner for the careful review and consideration of the current application.

I. Status

In the Office Action, Claims 1, 2, 5, 7, 8, 22, 29, and 30 stand rejected under 35 U.S.C. §102 (e), as being allegedly anticipated by Janik et al. (Janik, US Patent Publication No. 2002/0078248, hereinafter "Janik"). Claims 4 and 27 are rejected under 35 U.S.C. §103 (a) as being allegedly unpatentable over Janik as applied to claims 1 and 22 above. Claims 3, 6, 23-26 and 28 stand rejected under 35 U.S.C. §103 (a) as being allegedly unpatentable over Janik in further view of Townsley et al. (Townsley, US Patent No. 5,666,06, hereinafter "Townsley"). Claims 9-21 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Janik in further view of Townsley.

II. Amendments

Amendments have been made to the specification in light of the objections made in the Office Action. No additional material has been added to the specification.

Claim 21 has been amended to correct an antecedent basis error in claim 21. The identifier "the" has been changed to the identifier "a". Since the term after the identifier has not changed, this is not a narrowing amendment.

II. Discussion of Rejections

A. Rejections under 35 U.S.C. §102

Claims 1, 2, 5, 7, 8, 22, 29, and 30 stand rejected under 35 U.S.C. §102 (e), as being allegedly anticipated by Janik. Applicants respectfully traverse these rejections. Claims 1 and 22 are independent claims. Claims 2, 5, 7, and 8 depend from Claim 1. Claims 29 and 30 depend from Claim 22.

1. Standard under 35 U.S.C. §102

A rejection under §102 is proper when the cited art shows all portions of the claimed invention. When all the portions are not shown, §102 is not a proper basis for rejection.

2. Rejections under 35 U.S.C. §102 as allegedly anticipated by Janik

a. Claim 1

i. The Janik Patent Publication is improper art.

A reading of Janik should highlight that the publication of the Janik application was June 20, 2002, and that it was filed on Sept. 4, 2001. The Janik application makes a priority claim to United States provisional Application No. 60/230,084, filed Sept. 5, 2000 (hereinafter “the Janik Provisional”).

The rejection under the Janik application is made under §102(e). §102(e)(1) requires the proper prior art be proper, it must be one in which the “invention is described

in (1) an application for patent, published under Sec. 122(b) ... before the invention by the Applicants.” The MPEP describes the critical date of a patent application publication as the date of the provisional, if entitled to the benefit of the provisional application.

In the present case, there is no indication that the portions cited in the Office Action are entitled to the filing date of the provisional date. In order to be entitled to the provisional date, the subject must be described in the provisional itself. The Office has supplied no indication that the cited references were provided in the provisional, and thus, there is no indication that the cited portions are entitled to the earlier provisional date. Applicants respectfully request that the provisional application be forwarded to ascertain whether the cited portions are contained within the Janik Provisional.

ii. **Janik does not show or suggest portions of the claimed invention**

Claim 1 is directed to “a wireless communication device for allowing wireless communication for a personal data assistant coupled with the wireless communication device[.]” The wireless communication device has “a modem” and “a pass-through serial connector[.]” The pass-through serial connector is “*configured to allow simultaneous charging* of the wireless communication device and the personal data assistant[.]” (Emphasis added).

It is stated in the Office Action that Janik shows “a pass through serial connector [is] configured to allow simultaneous charging of the wireless

communication device and the personal data assistant ... (Figures 2, 4, and 5, and paragraphs 0033, 0039, and 0040)." (Office Action p. 3, first full para.) Applicants cannot find such support in the cited portions. Figs. 2, 4, and 5 do not provide any indication that the charging of the units happens simultaneously.

Paragraph 0033 of Janik states:

"[0033] Referring now to FIG. 9, PDA docking profile area 116 of PDA 2 is shaped to fit into cradle docking profile area 124 when PDA 2 is docked with PDA docking cradle 54. The shape of wireless LAN adapter module 14 in the adapter-to-PDA docking profile area 118 is the same shape as the cradle docking profile area 124 in PDA docking cradle 54."

Paragraphs 0039 and 0040 of Janik state:

"[0039] Referring now to FIG. 6, FIG. 7, and FIG. 8, in one embodiment, a PDA-side serial port 130 is functionally connected to adapter-to-PDA connector 22, and is an EIA/TIA-562 compliant serial port. A first serial port, cradle-side serial port 132, is functionally connected to adapter-to-cradle connector 24, and is an EIA/TIA-562 compliant serial port. The inclusion of PDA-side serial port 130 cradle-side serial port 132 on wireless LAN adapter module 14 provides the ability for PDA 2 standard serial port communication functions to occur while wireless LAN adapter module 14 is connected to PDA 2, such as PDA 2 to PC data synchronization or the use of a keyboard peripheral.

[0040] When conventional serial data is present at cradle-side serial port 132, control firmware 92 running on microprocessor 90 recognizes this and coordinates the transfer of serial data from cradle-side serial port 132 to PDA-side serial port 130, so that the serial data is present at PDA serial port 126. Conventional serial data is effectively transferred between a serial peripheral device such as docking cradle 54 and PDA 2 as if wireless LAN adapter module 14 were not present."

Accordingly, nothing in the portions cited by the Office tend to support that the serial connection is "configured to allow simultaneous charging of the wireless

communication device and the personal data assistant[.]” A further reading of Janik further defeats the application of Janik to the claimed invention. Janik reads, at para. 0044:

“[0044] For example, standard procedure for charging lithium batteries does not allow for both batteries to be charged simultaneously. Thus, microprocessor 90 may be programmed to determine which battery to charge by monitoring the charge levels of each battery and charging the battery with the smaller charge first. When that battery reaches 100 percent charge, the charger begins charging the other battery. The wireless LAN adapter module 14 includes a MOSFET circuit 142, an electrically controlled, very low resistance analog switch, which allows the charger to electrically connect with and disconnect from the appropriate battery.” (Emphasis added)

Accordingly, the Janik application should be read as actually teaching away from the claimed invention. This is particularly evident when reading the entirety of paragraph 0044, where the disclosure specifically points out the problems associated with simultaneous recharging, and includes specialized circuitry for “begin[ning] to charg[e] the other battery.”

iii. Claim 1 is allowable over Janik

Accordingly, for the reasons stated above, among others, the rejection of Claim 1 under §102 is respectfully traversed. Applicants believe that Claim 1 is allowable, and respectfully requests an indication from the Examiner to that effect.

b. Claims 2, 5, 7, and 8

Claims 2, 5, 7, and 8 depend from Claim 1. Accordingly, for the reasons stated above related to the allowability of Claim 1, among others, the rejections of Claims 2, 5,

7, and 8 under §102 are respectfully traversed. Applicants believe that these Claims are allowable, and respectfully request an indication from the Examiner to that effect.

c. **Claim 22**

i. **The Janik art is not proper art**

As with Claim 1, it is respectfully asserted that the Janik reference is an improper reference. Thus, the cited portions of the Janik reference cannot be used against the currently claimed invention.

ii. **Janik does not show portions of the claimed invention**

Claim 22 is directed to a wireless communication device that provides wireless communication to a personal data assistant where the wireless communication device is configured to hold the personal data assistant. The wireless communication device has “a first end . . . including a serial port connector[.]” The wireless communication device has “a top housing . . . *having clips opposite the first end* of the wireless communication device,” where “the clips [are] configured to engage the personal data assistant with the wireless communication device.” (Emphasis Added).

Turning to the Janik reference, it should be apparent that the Janik device has no clips that engage the personal data assistant. The Janik reference describes that a “latch hook” is placed into a “latch hole” in the PDA. In short, the “hook” system of Janik is not a “clip”, and thus the portion of the claimed invention calling for “clips opposite the first end” is not shown or suggested by Janik.

iii. Claim 22 is allowable over Janik

Accordingly, for the reasons stated above, among others, the rejection of Claim 22 under §102 is respectfully traversed. Applicants believe that Claim 22 is allowable, and respectfully requests an indication from the Examiner to that effect.

b. Claims 29 and 30

Claims 29 and 30 depend from Claim 22. Accordingly, for the reasons stated above related to the allowability of Claim 22, among others, the rejections of Claims 29 and 30 under §102 are respectfully traversed. Applicants believe that these Claims are allowable, and respectfully request an indication from the Examiner to that effect.

B. Rejections under 35 U.S.C. §103 (a)

1. Standard under 35 U.S.C. §103

According to the Manual of Patent Examining Procedure (M.P.E.P.),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants's disclosure.”¹

¹ M.P.E.P § 2143.

2. Rejections under 35 U.S.C. §103 as allegedly unpatentable over Janik

Claims 4 and 27 are rejected under 35 U.S.C. §103 (a) as being allegedly unpatentable over Janik as applied to claims 1 and 22 above. Applicants believe that these Claims are allowable, and respectfully request an indication from the Examiner to that effect.

a. Claim 4

Claim 4 depends from Claim 1, and for the reasons stated above in relation to Claim 1, among others, Applicants respectfully traverse the rejection of Claim 4.

b. Claim 27

Claim 27 depends from Claim 22, and for the reasons stated above in relation to Claim 22, among others, Applicants respectfully traverse the rejection of Claim 27.

3. Rejections under 35 U.S.C. §103 (a) as being unpatentable over Janik in view of Townsley.

Claims 3, 6, 9-21, 23-26 and 28 stand rejected under 35 U.S.C. §103 (a) as being allegedly unpatentable over Janik in further view of Townsley. Claims 9 and 17 are independent claims. Claims 3 and 6 depend on Claim 1. Claims 10-16 depend on Claim 9. Claims 18-21 depend on Claim 17. Claims 23-26 and 28 depend on Claim 22.

a. Janik is improper art

As related above with reference to the arguments presented for Claims 1 and 22, it is believed that Janik is improper art. Accordingly, all the §103 rejections based on Janik are all believed to be improper.

b. Claim 9

Claim 9 contains many of the features referred to above in Claim 1 relating to the timing of the charging of the device and the PDA. Accordingly, Janik does not show the portions of Claim 9 relating to “simultaneous charging” of the units through an “external serial connector[.]” In the Office Action, the Examiner uses Townsley to attempt to correct the shortcomings of Janik.

i. Townsley does not make up the differences

Townsley is art that reads on simultaneous charging of batteries located in a computer. If one were to place the “simultaneous charging” capability of Townsley into the apparatus of Janik, it would render an inoperative apparatus. To wit, Townsley states that the described charging apparatus “supports . . . simultaneous charging of the batteries provided that . . . the computer system is in low power “Sleep” or “Shutdown” modes.

Further, there is no indication how to couple the apparatus of Townsley to charge over a serial line, as described in the claimed invention. Thus, several problems make the use of Townsley inoperative when placed in the Janik apparatus.

ii. There is no motivation to combine

In the Office Action, it is stated that “[i]t would have been obvious to one skilled in the art at the time of the invention to include Janik’s PDA/modem combination, [and] Townsley’s charging circuitry for the purposes pf charging both batteries at the same time[], [or] for the purposes of safety.” While these are all wonderful results, the Office has provided no objective indicia of the motivation to combine. Accordingly, under *In re Lee*, an articulable reason to combine must be made within the context of the cited art.

As mentioned previously, it should be noted that the Janik teaches away from the proposed combination. Second, the Office Action reads that “[i]t would have been obvious to one skilled in the art at the time of the invention to include Janik’s PDA/modem combination, [and] Townsley’s charging circuitry[.]” The Examiner should note that Janik (in its present form) was filed in September 2001. Thus, at the time of the invention, Janik specifically teaches away from the idea of charging both batteries simultaneously, or from using the Townsley apparatus with the apparatus. Thus, it should be clear that Janik contemplated the charging question (since it is mentioned in Janik), and dismissed the possibility that it could be done. Thus, the objective showing in Janik is that one skilled in the art at the time of the invention did not find it obvious, since Janik considered the same problem and dismissed it. Accordingly, the argument that the combination is obvious is not proper based on the fact that Janik considered and rejected the idea.

iii. **Claim 9 is allowable over Janik in light of Townsley**

Based on the arguments above, in addition to others, it should be clear that the prima facie case of obviousness cannot be sustained in the present instance for the rejection of Claim 9 as allegedly being obvious. Therefore, Applicants respectfully traverse the rejection of Claim 9 under §103 over Janik in light of Townsley. Applicants request that the Examiner issue a notice indicating the allowability of Claim 9.

b. Claim 17

Claim 9 contains many of the features referred to above in Claim 1 relating to the timing of the charging of the device and the PDA. Accordingly, Janik does not show the portions of Claim 9 relating to “simultaneous charging” of the units through an “external serial connector[.]” As shown above, Townsley does not correct the shortcomings of Janik, nor is there a motivation to combine the references since Janik teaches away from the possibility. Accordingly, for many of the same reasons stated above in relation to Claim 9, among other reasons, it is believed that Claim 17 is allowable. Accordingly, Applicants respectfully traverse the rejection of Claim 17 under §103 over Janik in light of Townsley. Applicants request that the Examiner issue a notice indicating the allowability of Claim 17.

c. Claims 3, 6, 10-16, 18-21, 23-26, and 28

Claims 3 and 6 depend on Claim 1. Claims 10-16 depend on Claim 9. Claims 18-21 depend on Claim 17. Claims 23-26 and 28 depend on Claim 22.

For Claims 3 and 6, Townsley does not make up the shortcomings of Janik relative to Claim 1, nor is there a motivation to combine Townsley with Janik. Accordingly, for the reasons stated above in relation to Claim 9, among others, the rejections of Claims 3 and 6 are respectfully traversed.

For Claims 23-26 and 28, Townsley does not make up the shortcomings of Janik relative to Claim 22, nor is there a motivation to combine Townsley with Janik. Accordingly, for the reasons stated above in relation to Claim 9, among others, the rejections of Claims 23-26 and 28 are respectfully traversed.

For Claims 10-16, Townsley does not make up the shortcomings of Janik relative to Claim 9, nor is there a motivation to combine Townsley with Janik. Accordingly, for the reasons stated above in relation to Claim 9, among others, the rejections of Claims 10-16 are respectfully traversed.

For Claims 18-21, Townsley does not make up the shortcomings of Janik relative to Claim 17, nor is there a motivation to combine Townsley with Janik. Accordingly, for the reasons stated above in relation to Claim 17, among others, the rejections of Claims 18-21 are respectfully traversed.

CONCLUSION

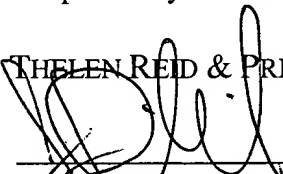
It is believed that this Response and Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

A check is attached for the requisite amount, and should the amount be less than required, the Commissioner is hereby authorized to deduct the proper amount from Deposit Account 50-1698.

Respectfully submitted,

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